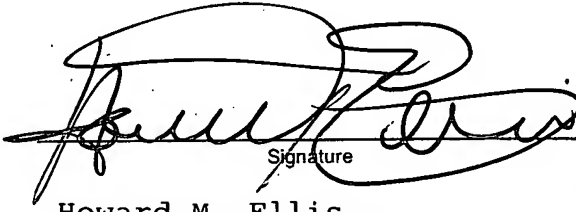




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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		TCHP:101 US	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>November 07, 2005</u> Signature <u><i>Ramona Jones</i></u> Typed or printed name <u>Ramona Jones</u>		Application Number	Filed
		10/626,145	07/24/2003
		First Named Inventor	
		Gerald ARSENAULT et al.	
		Art Unit	Examiner
		3676	Mark Williams
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Howard M. Ellis Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>25,856</u>		716-626-1564 Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		November 07, 2005 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Gerald Arsenault et al.

Art Unit 3676

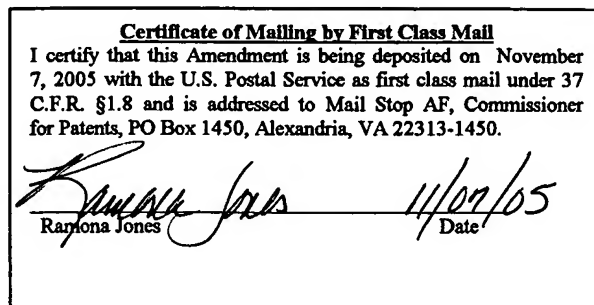
Application No.: 10/626,145

Filed: July 24, 2003

Confirmation No.: 9311

Examiner: Mark Williams

For: CASTER ASSEMBLY



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in support of Applicant's Pre-Appeal Conference (Pilot Program). Applicant has filed a Notice of Appeal concurrently with this brief and Pre-Appeal Brief Request for Review.

Status of Application:

Claims 1-22 are in this application, and have been finally rejected. No claims have been allowed.

In response to the rejection made Final in the Office Action of August 22, 2005, Applicant filed a Request for Reconsideration on September 15, 2005. An Advisory Action of September 29, 2005, indicated Applicant's response was not persuasive.

THE CLAIMED INVENTION

Claim 1, the broadest rejected claim is drawn to an apparatus for attaching a wheeled element (e.g., caster). The **structural features** of claim 1 are best illustrated by Fig. 4 of the drawings, and comprises:

- (i) a caster bracket 12 (Fig. 4) with flanged edges (16, 14) and a non-flanged edge (Fig. 4) for receiving a connecting plate (34) of a wheeled element (44);
- (ii) a flexible member (26) for immobilizing the connecting plate 34 of the wheeled element (44), wherein the flexible member (26) comprises extension (30) (See Fig. 1) having a length extending past the perimeter of the caster bracket (12) (best seen in Fig. 3), and
- (iii) **the extension means (30) extending past the perimeter of the caster bracket having the non-flanged edge.**

THE REJECTION

The one (1) remaining ground of rejection is: Claims 1-22 stand rejected under 35 U.S.C. 103(a) over Kaneko (US Pat. 3,935,613) in view of Chung et al (US Pat. 4,227,281).

THE CITED ART

Kaneko (US Pat. 3,935,613)

(1.) **Kaneko** discloses a detachable caster roller 24 (Fig. 2) with an anchoring seat (Figs. 1 and 3) for the caster roller (24) in two embodiments (depicted in Figs. 1 and 3).

(2.) The anchoring seat of Fig. 1 of Kaneko contains two opposing grooves (flanges) 14 and a rear mounted stop bar (un-numbered). A fourth edge of **Kaneko's** first anchoring seat (Fig. 1) **lacks a flange** to allow the caster base plate 26 to be slidably mounted into the anchoring seat. The anchoring seat of Fig. 1 contains a resilient stopper 16 with a projection 18 as retaining means which can be depressed and released to engage with opening 34 of caster base plate 26.

(3.) Like the first embodiment of the anchoring seat of Fig. 1, the second embodiment of the anchoring seat (Fig 3) of **Kaneko** also comprises two opposing grooves (flanges) 40 and a rear stop bar (un-numbered) at the back edge of the anchoring seat. Like the anchoring seat of Fig. 1, the anchoring seat of Fig. 3 of **Kaneko** also lacks a flange on the fourth edge to allow installation of the caster base plate 26. In this regard, the bottom panel of the anchoring seat of

Fig. 3 contains two slits 44 which form a resilient depressible tongue 46 with two point projections 50 for engaging with openings 34 in caster plate 26, to hold the caster plate in a locked position.

(4.) It is believed especially noteworthy, the anchoring seats of Figs. 1 & 3 of **Kaneko** have flanges and a stop bar on three (3) edges. The fourth edge lacks a comparable flange in order to allow slidable entry and installation of base plate 26 onto the anchoring seat in each embodiment.

Chung et al (US Pat. 4,227,281)

(1.) Importantly, **Kaneko supra** fails to teach or suggest Applicant's flexible member (26) having an extension (30) (See Fig. 1) **with a length extending past the perimeter of the caster bracket (12) having the non-flanged edge** (Best seen in Applicant's Fig. 3), **according to Applicant's claim 1;**

(2.) Chung et al disclose a caster pad (50) (See Figs 2-4) for receiving a caster plate (16) (Fig. 1) with caster (12) (Fig. 1).

(3.) Caster pad (50) (Fig. 2) of Chung et al comprises a pair of opposing flanges (52, 54) (Fig. 3) with **cut-outs (66) in flange (52) only** and a pair of oppositely disposed retaining lips/flanges (56, 58).

(4.) Chung et al also disclose a spring member (60) (Fig. 3) for engagement between edges of caster plate surface (44) and retaining lips/flanges (56, 58) of caster pad (50) (See Fig. 3) to securely hold the caster plate (44) to the caster pad (50).

(5.) Importantly, Chung et al also teach spring member (60) extending past the perimeter of caster pad (50) and in so doing engages with cut-outs (66) in flange (52). According to Chung et al, Col. 4, lines 7, et seq., flange 52, the **cut-out portions (66) which engage with the loop portion of the extension of spring (60) operate to prevent the spring from moving back and forth when engaged in the retaining lips (56, 58), (and apparently from disconnecting therefrom).**

ERRORS IN THE REJECTION

It is requested that the Pre-appeal Brief Conference Panel withdraw this one ground of rejection of claims 1-22 under 35 U.S.C. 103(a) over Kaneko in view of Chung et al in view of the following considerations:

(i) Neither Kaneko, nor Chung et al, taken alone or in combination, make out a *prima facie* case of obviousness under 35 U.S.C. 103 because neither reference teaches the limitation of claim 1 wherein extension means (30) (See Fig. 3) **has a length extending past the perimeter of the caster bracket (12) having the non-flanged edge** .

(ii) Chung et al employs a spring 60 that extends past the perimeter of caster plate (42) (Fig. 3). However, according the fundamental teachings of Chung et al the spring is required to engage with cut-out portions (66) in flange 52 to avoid movement (and possible dislodging).

(iii) However, Applicant's claim 1 expressly provides the extension means (30) extends past the perimeter of the caster bracket having a **non-flanged edge** . In other words, the spring extension 60 of Chung et al would be **inoperative** in the caster bracket of Kaneko because the absence of a flange and the required cut-out portions (66) to engage and lock the spring in place according to teachings of Chung et al. References cannot properly be combined if the effect would destroy the invention on which one of the references is based. *Ex parte Hartmann* 186 USPQ 186 (PTO Bd. Appeals 1974) Fig. 3 of Applicant's drawings clearly illustrates extension (30) passing across the edge of the caster bracket **lacking the flange and cut-out portions needed for retaining the spring in a locked position to avoid movement back and forth.**

(iv) The Examiner's response to Applicant's argument that Chung et al's spring extension would become inoperative in the absence of a flange with cut-outs is to be found on the bottom of page 3 of the Office Action of August 22, 2005, wherein the Examiner urges: "Chung et al are relied on solely for their teaching of the concept of extending the flexible securing means past the periphery of the bracket; not for replacing the securing means of Kaneko for that of Chung.

(v) Applicant's request for reconsideration filed September 15, 2005, stated Applicants maintain this conclusion is **improper** and not in compliance with Office practices and guidelines, and a large body of supporting law on the subject. For example, Section 2141 (page 2100-127) of the MPEP expressly provides : **THE PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.**

The above statement from the MPEP means that in applying the prior art in rejecting claims, **all teachings** of the document must be considered **as a whole**, and one is **not** at liberty to

exclude those that would lead away from the claimed invention.

Applicant urged: Chung et al also teach that operation of spring 60 is dependent on the presence of flange 52 having slots 66 which locks the spring, so the caster plate is flush against the caster pad to retain it in a locked position. In other words, without slotted flange 52 of Chung et al, the spring 60 is subject to release itself, and therefore, is functionally inoperative.

Hence, successful use of spring 60 of Chung et al is dependent on the presence of a locking flange at the edge of the caster plate adjacent to edge where spring 60 extends. Kaneko lacks (and amended claim 1) lack the necessary flange configuration to retain the spring 60. The Examiner is not at liberty to disregard such omissions because he wishes to rely only on a "general concept" of extending the flexible securing means past the periphery of the bracket.

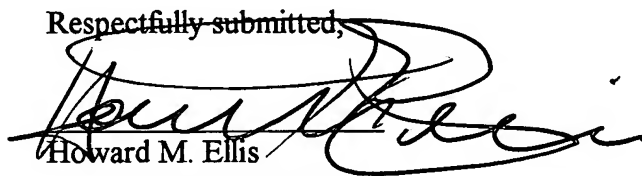
Simply stated, the Examiner's conclusion of obviousness was arrived at by disregarding certain fundamental teachings of Chung et al, which is in violation of Office guidelines set-forth in the MPEP, *supra*.

CONCLUSION

The one ground of rejection for reasons of obviousness under 35 U.S.C. 103(a) over Kaneko in view of Chung et al **should be reversed** because the prior art taken as a whole fails to make out a *prima facie* case of obviousness. The final rejection of claims 1-22 clearly omits significant requirements of Chung et al which omissions are probative evidence of **non-obviousness**, which the Final Rejection tacitly acknowledges, but refuses to consider and give appropriate weight.

November 07, 2005

Respectfully submitted,


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